

REMARKS

In the Final Office Action dated September 8, 2004, the Examiner rejects claim 3, the only pending claim, under 35 U.S.C. §102(b) as being anticipated by Smith et al., U.S. Patent No. 4,735,626 ("Smith"). Applicants respectfully traverse the rejection.

The Examiner contends that Smith discloses an air freshener unit comprising a porous high density polyethylene having a pore size of 10 to 100 microns, a void volume ratio between 30% and 55%, and a fragrance transfer rate of 46 mg per 60 minutes [46 mg/hour]. The Examiner further contends that although Smith does not disclose that the fragrance material does not leak from the wick material when the wick material is inverted, this property would be inherent. This position is based on the Examiner's contention that Smith discloses "all of the structural limitations and chemistry" of claim 3, "i.e., pore size, void volume ratio and transfer rate", and that these limitations are critical in attaining the non-leakage of the fragrance from the wick material.

Applicants disagree with the logical jump made by the Examiner where, as between Smith and claim 3, similar materials are put to different uses as different devices with clearly distinct modes of operation and function. To quote the Examiner's own words, "**[t]he claim recitation and the reference disclosure are directed to two totally different stories.**" Applicants could hardly state it better. Smith merely discloses an object that is impregnated with a fragrance and later inserted into the dust bag of a vacuum cleaner. See Col. 1, ll. 18-20; col. 3, ll. 55-57. In contrast, claim 1 recites a "wick for use in connection with an air freshening device."

More specifically, Smith merely discloses a "porous, synthetic, polymeric support impregnated with a fragrance." Abstract, Col. 1, ll. 18-20. This support "unit" is impregnated with a fragrance oil by soaking it until no more fragrance can be absorbed without the surface of the support dripping liquid fragrance. Col. 5, ll. 37-46. The soaked unit is then packaged. Later the support "unit is removed from any packaging and is inserted into the dust collection chamber or dust bag of a vacuum cleaner." Col. 3, ll. 55-57. Smith does not disclose an air freshener that functions through wicking.

The Examiner states that "a device that ... transports vaporizable material" is not

commensurate with the scope of claim 3. Applicants respectfully disagree. Claim 3, in addition to positively reciting “wick” or “wicking” multiple times, also positively recites “a combination of said pore sizes and said void volume ratio are selected such that (i) a vaporizable material to be transported by the wick material does not leak...” and “... a vaporizable material to be transported by the wick material is delivered ...” Indeed, transportation of a vaporizable material is understood in the air freshening business to be the function of a wick.

Applicants respectfully note that, not only does Smith not disclose a wicking device, none of the references cited by the Examiner (after three searches) disclose an air freshener wick. In fact, the references teach away from an air freshener wick, for example, by teaching a material that is soaked and packaged as described above. Applicants further assert that the air freshener wick of claim 3 is not obvious in light of any of the references cited by the Examiner.

The Examiner assumes that even though Smith does not disclose a wick, it would perform as a wick because the pore size and void volume ratio ranges disclosed in Smith happen to overlap those recited in claim 3.¹ However, Smith does not in any way disclose “a combination of said pore sizes and said void volume ratio are selected such that (i) a vaporizable material to be transported by the wick material does not leak from the wick material when the wick material is inverted”

Applicants assert that the device of Smith can not be inverted. Stated otherwise, given that the device of Smith is not a wick, there is no common understanding of up or down relative to the Smith device or of how to identify a direction of wicking. In contrast, an air freshener wick is commonly understood to wick fragrance from an area of high concentration to an area of lower concentration. There is no reason why turning over the device of Smith would increase its propensity to leak. The Examiner has cited none. However, it is commonly understood that in an air freshener device, inversion of the wick could give rise to over-saturation and leaking.

Applicants claim a wick with properties selected from within certain recited ranges where the selection creates a wick that does not leak when inverted. Applicants note that because the device of Smith discloses leaking under some conditions, it is possible that the Smith device

would leak and that therefore the Examiner's inherency argument is improper. Ironically, in the September 8, 2004 Office Action, the Examiner's counter argument is essentially the Smith does not disclose a wick or inversion, and therefore does not disclose whether the device of Smith would leak under conditions of wick inversion. The Examiner states that "[t]he claim recitation and the reference disclosure are directed to two totally different stories." This underscores Applicant's position that an inherency argument is not proper in this situation. What is known is that, according to Smith, under some conditions the device of Smith will leak. Smith does not disclose whether those conditions would arise if the material were used as a wick in an air freshener when inverted, but the possibility is certainly present.

The case law is clear that in a proper application of inherency, the Examiner must prove that the undisclosed performance factors must necessarily be present, and that it would be so recognized by persons of ordinary skill in the art. In re Best, 562 F.2d 1252, 1255 U.S.C.C.A.P.A. 1977; and Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). It is not enough to assert that the undisclosed performance factors might, sometimes, result from the disclosed structural elements. Scaltech, Inc. v. RETEC/TETRA, L.L.C., 178 F.3d 1378 (Fed. Cir. 1999) ("Inherency may not be established by probabilities or possibilities.") Smith itself appears to rebut the Examiner's inherency argument. Smith teaches that one must stop loading the 'support unit' at the point that it would drip. Col. 5, ll. 37-46. Therefore, because Smith discloses that under some conditions the material would drip, the no-drip property is not necessarily present and cannot be inherent.

The Examiner cites Ex parte Tummers et al., 137 USPQ 444 as holding that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. However, in Tummers both the prior art reference and the claimed invention at issue involved the same semiconductor chip and the function of the same alloy material. In Tummers, the claimed function was an improved gain characteristic of the semiconductor, whereas the prior art disclosed improvement in controlling depth of penetration of indium in the semiconductor and improved performance of the

¹ "[I]t is not seen that the porous support unit of Smith would have performed differently than the wick of the present invention when they are both fabricated from the same polymeric material and possess similar pore size and porosity." Office Action, pg. 2, paragraph 3.

semiconductor at higher frequencies. Furthermore, in Tummers, it was held that there was “no clear basis for the examiner’s conclusion that the [reference], alone, suggests the use of [two elements mentioned for other reasons in the specification of the reference] for patentee’s purposes or for achieving the gain characteristic taught by the appellants.” Here, in contrast, the reference device (an air freshener impregnated sponge-like device in a vacuum bag) is not the same device (it is not a wick) and does not function (does not perform wicking) as the device of the reference device. Instead the claimed device comprises an air freshener wick configured for wicking and with functional properties not applicable in Smith. Thus, Ex parte Tummers does not support the Examiner’s position.

Thus, Smith does not disclose, “A porous polymeric wick for use in connection with an air freshening device consisting essentially of: a high density polyethylene wicking material having a void volume ratio on the order of between about 30 to about 35% and having an average pore size in the range of from about 3 to 30 microns, wherein a combination of said pore sizes and said void volume ratio are selected such that (i) a vaporizable material to be transported by the wick material does not leak from the wick material when the wick material is inverted and (ii) a vaporizable material to be transported by the wick material is delivered via volitization from said high density polyethylene wicking material at a rate of about 30 to about 70 mg per hour.” (emphasis added)

Therefore, because each and every element is not disclosed by Smith, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn. Furthermore, because Smith does not disclose all of the elements of claim 3, such as a wick and the no-leak property, and since the Examiner has presented no evidence that the undisclosed elements are necessarily present, the inherency doctrine is inapplicable. Applicants respectfully request that the section 102 and inherency argument be withdrawn and that claim 3 be allowed.

In accordance with MPEP §706.07(f), should the Examiner not find the application in condition for allowance, Applicants look forward to an advisory action at Examiner’s earliest opportunity.

CONCLUSION

Therefore, the cited references do not disclose each and every element of claim 3. Accordingly, Applicants respectfully request allowance of the pending claim. The Examiner is invited to telephone the undersigned at (602) 382-6337 at the Examiner's convenience, if that would help further prosecution of the subject Application. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814. **This statement does NOT authorize charge of the issue fee.**

Respectfully submitted,

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